REMARKS

Applicants have reviewed the Office Action of January 3, 2003 and have provided clarifying amendments to overcome the present rejections and to further expedite prosecution of this application. Reconsideration is therefore earnestly requested. No new matter is added with this amendment.

Claims 58-65 are presently rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. In particular, the Office Action alleges that the claims do not address technology as related to or as an integral part of business process. In response, Applicants have amended independent claim 58 to recite computer related components for each step limitation. Applicants submit that claims 58-65, as amended, recite a method which produces a useful, concrete and tangible result. In particular, claims 58-65 have been amended to explicitly set forth the physical structure that is inherent in the invention, as originally claimed. Structural limitations have been added to explicitly recite a depository, server and a display associated with the claimed functionality. In addition, independent claim 58 recites that the method is a computer implemented method.

Claims 58-75 are presently rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 6,324,523 B1 to Killeen, Jr. *et al* over SchwabLife webpage, copyright year 2000.

Killeen, Jr. *et al* discloses an integrated client relationship management processor for managing an alternate account tracking and record keeping mechanism that coordinates a plurality of financial services with ***an asset-based fee alternative*** to traditional commission-based pricing (col. 1, lines 59-63). As described in column 3, lines 38-45, the principle purpose of the service is to provide access to trading and a host of other important services *without the*

payment of separate transaction charges at the time of each eligible transaction, thereby forming a major segment of account tracking and record keeping. Killeen, Jr. *et al* mentions a methodology for multiple account management wherein a collection of financial services is available to the multiple accounts based upon aggregate assets (col. 1, lines 64-67).

The Office Action alleges that Killeen, Jr. *et al* discloses a server for assessing the client portfolio and assigning a plurality of services to a plurality of service provider groups wherein the step of assigning further comprises the steps of determining whether each service is needed by the client on a frequent basis and determining whether a level of value to the client is above a predetermined level. More specifically, the Office Action relies on Killeen, Jr. *et al*'s disclosure of Bronze, Silver, Gold, Platinum, and Platinum Plus service levels.

Applicants respectfully disagree with the Office Action's assertions. Killeen, Jr. *et al* states that the level of service is determined by the ***amount of eligible assets*** in the eligible account(s) (col., 4, lines 61-62). To attain more services, such as more trades and more non-transaction services, the ***value of the eligible assets must increase*** (col. 4, lines 62-64). In Killeen, Jr. *et al*, there is no involvement of consumer perspective as claimed by Applicants in determining the level of service. Rather, Killeen, Jr. *et al* relies on a quantitative determination based on the amount of assets. For example, for two accounts with the same value of assets, the first account and the second account would be eligible for the same level of service because the amount of assets is the same, according to Killeen, Jr. *et al*'s disclosure. However, according to an embodiment of Applicants' claimed invention, while two accounts may have the same value of assets, the first account and the second account may be eligible for two different levels of service, based on how frequent the client needs a service and a level of value to the client. Thus,

Killeen, Jr. *et al* discloses *a quantitative determination* of levels of service based strictly on asset amounts while an embodiment of Applicant's claimed invention involves *a qualitative determination* of levels of service which involves the client's personal needs and goals.

An embodiment of Applicants' invention as claimed is directed to "(b) assessing the client portfolio based at least in part on the client goal; (c) assigning a plurality of services to a plurality of service provider groups, further comprising the steps of: (i) ***determining whether each service is needed by the client on a frequent basis***; (ii) ***determining whether a level of value to the client is above a predetermined level***; and (iii) categorizing the plurality of services into a core service provider group, an affiliated service provider group and a non-affiliated service provider group, ***wherein the step of categorizing is based at least in part on the steps of determining***." Killeen, Jr. *et al*, alone or in combination with any other reference of record, fails to show this combination of claim limitations.

In addition, Killeen, Jr. *et al* fails to disclose, suggest or teach the step of categorizing the plurality of services into at least **a core service provider group** and **an affiliated service provider group**. There is no disclosure for supporting these limitations in Killeen, Jr. *et al.* The Office Action acknowledges that Killeen, Jr. *et al* fails to disclose the **non-affiliated service provider group** or that this group represents services needed by the client on an infrequent basis or having a level of value below the predetermined level indicating a secondary level of service. For this deficiency, the Office Action relies on the SchwabLife webpage. In particular, the Office Action relies on a statement that insurance policies are underwritten and issued by Great-West Life & Annuity Insurance Company. This statement shows, at most, that Charles Schwab & Co. works with an entity that provides insurance policies. There is no suggestion that the

SchwabLife webpage performs the steps of (i) ***determining whether each service is needed by the client on a frequent basis***; (ii) ***determining whether a level of value to the client is above a predetermined level***; and (iii) categorizing the plurality of services into a core service provider group, an affiliated service provider group and a non-affiliated service provider group, ***wherein the step of categorizing is based at least in part on the steps of determining***, as claimed by Applicants.

Therefore, the Office Action fails to show any motivation as to why one of ordinary skill in the art would have been motivated to combine the data processing system of Killeen, Jr. et al with the SchwabLife webpage that provides a single statement indicating life insurance policy services are provided with an entity. The mere fact that two references can be combined or modified does not render the resultant combination or modification obvious unless there is a suggestion or motivation found somewhere in the prior art regarding the desirability of the combination or modification. *See* MPEP § 2143.01*; see also In re Mills*, 16 U.S.P.Q.2d 1430, 1432 (Fed. Cir. 1990); *In re Fritz*, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). In addition, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

In *In re Hedges*, 783, F.2d 1038, 1041, 228 U.S.P.Q. 685, 687, (Fed. Cir. 1986), the U.S. Court of Appeals for the Federal Circuit stated that "the prior art as a whole must be considered. The teachings are to be viewed as they would have been viewed by one of ordinary skill." The court also stated that "'[i]t is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the

exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art'" (quoting *In re Wesslau*, 353 F.2d 238, 241, 147 U.S.P.Q. 391, 393 (CCPA, 1965)).

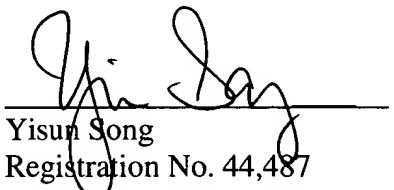
The cited references fail to show, teach or make obvious the invention as claimed by Applicants. Further, none of the reference cited anticipate nor make obvious the invention as presently claimed. For at least the reasons presented above, the rejection should be withdrawn.

CONCLUSION

It is respectfully submitted that this application is in condition for allowance and such disposition is earnestly solicited. If the Examiner believes that prosecution and allowance of the application will be expedited through an interview, whether personal or telephonic, the Examiner is invited to telephone the undersigned with any suggestions leading to the favorable disposition of the application.

It is believed that no fees are due for filing this Response. However, the Director is hereby authorized to treat any current or future reply, requiring a petition for an extension of time for its timely submission as incorporating a petition for extension of time for the appropriate length of time. Applicants also authorize the Director to charge all required fees, fees under 37 C.F.R. §1.17, or all required extension of time fees, to the undersigned's Deposit Account No. 50-0206.

Respectfully submitted,



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